

## **REMARKS/ARGUMENTS**

### **Amendments**

Before this Amendment, claims 1-26 were present for examination. New claims 27-36 are added. No claims are amended or canceled. Therefore, claims 1-36 are present for examination, and claims 1, 21, 24, and 36 are the independent claims. No new matter is added by these amendments, as the amendments are clearly supported in the Specification (Original Application, p. 5, ll. 4-5, p. 13, ll. 19-22, p. 15, ll. 23-29, p. 16, ll. 1, p. 17, l. 25 - p. 18, l. 2).

The Office Action dated January 31, 2006 (hereinafter "Office Action") rejected claims 1-26 under 35 U.S.C. §103(a), as being unpatentable over the cited portions of U.S. Patent No. 6,532,589 to Proehl (hereinafter "Proehl") in view of the cited portions of U.S. Patent No. 5,619,247 to Russo (hereinafter "Russo"). The rejection is respectfully traversed.

### **35 U.S.C. §103(a) Rejection, Proehl, Russo**

The Office Action has rejected claims 1-26 under 35 U.S.C. §103(a) as being unpatentable over Proehl in view of Russo. To establish a *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP § 2143. The Applicants believe significant limitations from independent claims 1, 21, 24, and 36 are not found in the cited references.

Specifically, the references fail to teach or suggest 1) identifying when the user has tuned to a particular scheduled program with a counterpart stored on a server available for playback under the user's control, as recited in claims 24 and 36; 2) superimposing a notification symbol on the particular identified program, as recited in claims 24 and 36; 3) transmitting a notification signal to distinguish at least one of a set of programs on the server from programs not on the server, as recited in claim 1; or 4) transmitting a notification symbol within a system of scheduled programming to distinguish between those programs configured to be available under the control the user and those that are not configured to be available under the control the user, as recited in claim 21. As the following discussion illustrates, it is clear that the limitations

of the claims are *not* disclosed in the cited art. Reconsideration of the rejection is respectfully requested.

***A. Claims 24 and 36***

The Office Action states that claim 24 corresponds to subject matter of claim 1 and 2 (Office Action, p. 7). Thus, it appears that the Office Action relies on Proehl to teach the limitations from claims 24 and 36 cited above (Id., p. 4, *citing* Proehl, col.7, ll. 50-56, col. 8, ll. 10-45; Fig. 9). However, as illustrated below, Proehl clearly fails to suggest the specified limitations of claims 24 and 36.

Claims 24 and 36 recite *identifying* when the user has *tuned* to a particular *scheduled program* with a counterpart on the server. Proehl simply does not suggest this limitation, instead describing an EPG for a satellite system connected to a VCR (Proehl, col.7, ll. 50-56, col. 8, ll. 10-45; Fig. 9). The "TV planners" described in Proehl comprise daily, or monthly, calendars for scheduling, or reviewing, the recording of various programming.

Claims 24 and 36 are clearly different, as they specifically recite identifying when a user has tuned to a scheduled program with the requisite counterpart. This ability, in which tuning to a program is tied to the identification of that program as one having a counterpart on a server, is not found in Proehl. Instead, Proehl describes a calendar like EPG which shows programs recorded in the past or scheduled to be recorded in the future. It is clear that tuning to a scheduled program is quite different than viewing a calendar comprising a TV planner. Proehl simply fails to teach or suggest that tuning to a program with a server counterpart triggers the identification of the program as one with a counterpart.

Moreover, claims 24 and 36 recite superimposing the notification symbol on the program identified as having a server counterpart. The icons of Proehl represent past or future recordings, and are placed on the planner itself (Id., col. 8, ll. 10-35). Proehl fails to suggest that the icon be superimposed on the program identified as having a counterpart on the server which may be played under the user's control. Again, placing an icon on a TV planner is very different than superimposing a notification symbol on a program to which a user has tuned. The claims tie

the superimposition of the notification symbol to the viewing of a scheduled program, in a manner not suggested by the references. Tuning to a program with a counterpart on the server triggers the notification, and this connection is not suggested in Proehl.

***B. Claim 1***

Independent claim 1 recites transmitting a notification signal to distinguish at least one of the set of programs on the server from programs not on the server. The Office Action relies on Russo to teach this limitation (Office Action, p. 4, *citing* Russo, col. 5, ll. 45-55). But this portion of Russo fails to suggest the specified notification, as the Russo system instead "displays a list of prerecorded programs now available for viewing" (Russo, col. 5, ll. 47-49).

Russo itself makes clear that there may be many programs on the server that may not be available for viewing. Specifically, Russo points out that using "techniques such as 'parental lockout' or passwords, a subscriber may also be able to control access to the stored programs by children or unauthorized viewers (*Id.*, col. 4, ll. 65-67). Thus, a set of programs on the server may be quite different than programs available for viewing.

Claim 1 recites a notification signal to distinguish programs on the server from programs not on the server. The list of Russo affirmatively shows a list of programs available for viewing, and does not distinguish programs on a server from programs off the server, as specifically set forth in claim 1.

***C. Claim 21***

Independent claim 21 recites transmitting a notification symbol within a system of scheduled programming to distinguish between those programs configured to be available under the control the user, and those that are not configured to be available under the control the user. Although unclear, the Office Action apparently relies on Russo to teach this limitation (Office Action, p. 7, *citing* rejection to claim 1). But again, this portion of Russo fails to suggest the specified notification.

As noted above, the Russo system "displays a list of prerecorded programs now available for viewing" (Russo, col. 5, ll. 47-49). Russo fails to suggest a system to transmit a set of programs to a user according to a schedule of programming, wherein a notification symbol within the system distinguishes between those programs configured to be available under the control the user and those that are not configured to be available under the control the user.

The Office Action only generally cites to a previous rejection, while the claim limitations are different. In trying to understand the basis for the rejections, no particular teaching could not be found by the Applicants in the cited portions of the references.

"In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 CFR 1.1.04(c)(2)

Nonetheless, displaying a list of prerecorded programs on a VCR which are available for viewing is very different than distinguishing *scheduled programming* that is available under *playback control* from *scheduled programming* that is **not** available under *playback control*.

Independent claims 1, 21, 24, and 36 are allowable for at least the reasons cited above. Claims 2-20, 22, 23, and 25-35 each recite limitations in addition to those in the independent claims, and these dependent claims are believed allowable for at least the same reasons as given above.

### CONCLUSION

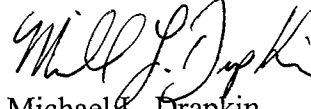
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Appl. No. 09/687,148  
Amdt. dated April 28, 2006  
Reply to Office Action of January 31, 2006

PATENT

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael L. Drapkin". The signature is fluid and cursive, with the first name "Michael" and last name "Drapkin" clearly distinguishable.

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